

REMARKS

The Official Action dated August 29, 2003 has been carefully considered.

Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

By the present Amendment, claims 48-71, 73 and 74 are amended to recite pet food products, in accordance with the teachings throughout the specification, including the examples. Accordingly, claim 72 has been cancelled. It is believed that these changes do not involve any introduction of new matter, whereby entry is believed to be in order and is respectfully requested.

In the Official Action, the Examiner indicated that claims 50-52, 56, 61, 66-68, 70 and 72 were withdrawn from consideration. Applicants submit however that withdrawal of claim 72 from consideration was in error as claim 72 was directed to a food product according to claim 64 wherein the food base comprises a pet food. Claim 64 was not withdrawn from consideration and the embodiment wherein the food base comprises a pet food was not the subject of an election of species requirement. Accordingly, reconsideration of the withdrawn subject matter, and examination of the present claims are respectfully requested.

Claims 48, 49, 53-55, 57-60, 62-65, 69, 71, 73 and 74 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Jackson et al published PCT application WO 98/04248 in view of the Fort translated German reference DE 29 805 782. The Examiner asserted that Jackson et al teach a dietary supplement composition for a post-menopausal woman containing 1-15 mg phytoestrogen and that Fort teaches a dietary cereal containing carnitine. The Examiner asserted it would have been obvious to add carnitine to the composition of Jackson et al to achieve the beneficial effect of supplementing the dietary

needs for a post-menopausal woman by supporting heart muscle activity and increasing stability against physical stress in view of Fort.

However, Applicants submit that the pet food products defined by claims 48, 49, 53-55, 57-60, 62-65, 69, 71, 73 and 74 are nonobvious over and patentably distinguishable from the combination of Jackson et al and Fort. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

More particularly, according to claim 48, the invention is directed to a pet food product comprising a pet food dietary composition including phytoestrogen, phytoandrogen or a mixture thereof, and at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid, and fructose oligosaccharide. The pet food product further comprises instructions for administering the dietary composition to a non-human mammal in an amount sufficient to reduce weight gain normally incurred in the non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy.

According to claim 60, the invention is directed to a pet food comprising a pet food dietary composition including a pet food base, phytoestrogen, phytoandrogen or a mixture thereof, and at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid, and fructose oligosaccharide. The pet food product further comprises instructions for administering the dietary composition to a non-human mammal in an amount sufficient to reduce weight gain normally incurred in the non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy.

According to claim 64, the invention is directed to a pet food product comprising a pet food dietary composition including a pet food base and a component comprising phytoestrogen, phytoandrogen, or estrogen or androgen derived from a fungal or microbial source, or a mixture of thereof, in an amount sufficient to reduce the weight gain normally

incurred in a non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy, or post menopause, when the dietary composition is administered to the non-human mammal on a regular basis, and at least one component selected from the group consisting of carnitine, inulin, conjugated linoleic acid and fructose oligosaccharide. The pet food product further comprises instructions for administering the dietary composition to a non-human mammal in an amount sufficient to reduce weight gain normally incurred in the non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy.

Jackson et al disclose dietary supplements that supply a variety of nutrients to supplement the dietary needs of women in order to prevent or reduce life-stage associated health risks during each principle adult life stage (page 8, lines 6-16). The Jackson et al compositions comprise specified amounts of calcium, magnesium, boron, copper, manganese, zinc, iron, folic acid, chromium, vitamin D, B₁₂, B₆, E, and C, and phytoestrogen in a biologically acceptable carrier. Applicants find nothing in Jackson et al to suggest a pet food product. Similarly, Applicants find nothing in Jackson et al suggesting a pet food product comprising a pet food dietary composition and further comprising instructions for administering the dietary composition to a non-human mammal in an amount sufficient to reduce weight gain normally incurred in the non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy. Applicants find nothing in Jackson et al to suggest that modification of the disclosed compositions could be useful to provide a pet food product to be administered to prevent weight gain in non-human mammals subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy, or post menopause, as provided by food products of the present invention.

Fort discloses a dietary food supplement that, due to the presence of L-carnitine and lecithin, helps to convert body fat into energy and to increase the useful conversion of sugar.

However, Applicants find no teaching or suggestion in Fort for modifying the teachings of Jackson et al to provide a pet food product comprising a pet food dietary composition, particularly in combination with instructions for administering the pet food dietary composition to a non-human mammal in an amount sufficient to reduce weight gain normally incurred in the non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy, as required by claim 48, claim 60, and claim 64.

To establish *prima facie* obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The mere fact that the prior art could be modified to result in a claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification, *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Similarly, in order for a combination of references to render an invention obvious, a combination of the teachings of all or any of the references must suggest, expressly or by implication, the possibility of achieving further improvement by combining such teachings along the lines of the invention, *In re Sernaker*, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). Applicants find no suggestion, express or implied, in either of the cited references relating to a pet food product comprising a pet food dietary composition, particularly in combination with instructions for administering the pet food dietary composition to a non-human mammal in an amount sufficient to reduce weight gain normally incurred in the non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy.

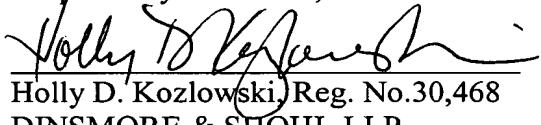
In the Official Action, the Examiner asserted that the claimed instructions are merely printed matter and therefore not considered a patentable limitation in claims to a composition. However, it is well settled that differences between an invention and prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter, *In*

re Gulack, 217 U.S.P.Q. 401, 403 (Fed. Cir. 1983). It is impermissible under §103 to dissect a claim, excise printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable; rather, the claim must be read as a whole, *In re Gulack, supra*. As the Federal Circuit has specifically noted, the fact that printed matter *by itself* is not patentable subject matter, because non-statutory, is not reason for ignoring it when the claim is directed to a combination; rather, the court looks to determine if a functional relationship exists between the printed matter and the remaining claim elements, *In re Gulack, supra* at 404.

In the presently claimed pet food products, there is clearly a functional relationship between the instructions for administering the pet food dietary composition to a non-human mammal, particularly in an amount sufficient to reduce weight gain normally incurred in the non-human mammal type subsequent to neutering, castration, spaying, ovariectomy or ovariohysterectomy. As this claimed combination of pet food dietary composition and instructions is neither taught nor suggested by the cited references, among or in combination, the presently claimed pet food products are nonobvious over and patentably distinguishable from the cited references. Accordingly, the rejection under 35 U.S.C. § 103 has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the rejection set forth in the Official Action, and places the present application and condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,


Holly D. Kozlowski, Reg. No. 30,468
DINSMORE & SHOHL LLP
1900 Chemed Center
255 E. Fifth Street
Cincinnati, Ohio 45202
(513) 977-8568